

RECEIVED  
CENTRAL FAX CENTER

AUG 01 2007

REMARKS

In the non-final Office Action mailed May 1, 2007, claims 1-49 were pending, and claims 1-49 were rejected. Claims 55-59 have been added in this response. Claims 30 and 41 have been cancelled since they are duplicative of the claims from which each depends. In view of the following remarks, reconsideration and allowance of the present application are hereby requested.

Claims 1-8, 16-21, 26-31, 36-41, and 46-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,185,356 to Parker et al. Claims 1-2, 4-8, 16-21, 26-27, 29-31, 36-37, 39-41, and 46 stand rejected under 35 U.S.C.(b) § 102(b) as being anticipated by U.S. Patent No. 3,796,214 to Davis. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the '356 patent in view of U.S. Patent No. 3,807,393 to McDonald. Claims 9-14, 22-24, 32-34, and 42-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker et al. Claims 15, 25, 35, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Parker et al. in view of U.S. Patent No. 5,293,863 to Zhu et al.

It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

Applicants submit that Parker et al. fail to at least disclose the features of claim 1 including a lighting element including at least one wall member, "said at least one wall member positionable along said inner wall surface and frictionally engageable with said inner wall surface, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor." (Emphasis added). Page 2 of the Office Action states:

Parker et al. disclose a surgical instrument including a retractor 2860 and a lighting element including multiple transmitting elements enclosed in a protective cover 2500 having cover portions or "wall members" 2500A and

Response to Non-Final Office Action  
Application No. 10/633,288  
Docket No. MSDI-261/PC750.00

Page 11 of 18

2500B wherein the cover portions can be made from an opaque or translucent material (Figs. 25A, 25B, 28A and 28B, col. 7, lines 6-45, col. 16, lines 13-65, col. 17, lines 19-35 and col. 18, lines 50-62).

As discussed in their January 31, 2007 Response to Office Action, the Applicants submit the sections of the '356 patent relied on by the Examiner do not disclose each of the features of claim 1. In the Response to Arguments section of the Office Action, the Examiner stated "[r]egarding the anticipation rejections over Parker et al. (US 6,185,356), the embodiment of Figures 25A and 25B does not show mechanical fasteners." Office Action, page 4. Applicants submit Parker et al. is silent as to how and/or even if the lighting device of Figures 25A and 25B is attachable to the retractor 2860. An anticipation rejection of claim 1 cannot properly be supported by the embodiment of Figures 25A and 25B since there is no disclosure in these Figures of the arrangement of elements recited in claim 1, and it is not proper to infer the arrangement of elements of claim 1 from the lack of fasteners shown in Figs. 25A and 25B. Additionally, looking to the embodiment of Figures 28A and 28B, Parker et al. disclose that "[a]ttachment member 2850 can take a variety of suitable forms, including adhesive tape, Velcro fasteners, clips, hooks, tabs, clamps, snaps and the like." See col. 18, lines 52-54. Furthermore, Parker et al. disclose that "protective cover 2850 [sic] may suitably include molded clips, hooks, tabs, or the like, for the attachment of an accessory." To that end, it is submitted that at least one wall member of the light transmitting member of Figures 25A and 25B and/or the light transmitting member 2810 is not frictionally engageable with the accessory device 2860. Instead, as indicated above, Parker et al. rely on a mechanical or adhesive connection to attach the light transmitting member to the accessory device 2860. Therefore, Parker et al. do not disclose all of the features of claim 1.

As discussed in their January 31, 2007 Response to Office Action, Davis discloses a perineal retractor 10 including a blade 12 to which tubular members 50, 51 may be engaged. However, instead of disclosing that at least one wall member of the tubular members 50, 51 is frictionally engageable to the retractor 10, Davis discloses that "[t]he tubular members may be joined to the blade by any conventional technique, such as soldering". See col. 3, lines 32-33. On page 4 of the Office Action, the Examiner states:

"[r]egarding the anticipation rejections over Davis (US 3,796,214) it is noted that the light transmitting elements frictionally engage or are frictionally engageable with the inside walls of tubular elements 50.51. One

Response to Non-Final Office Action  
Application No. 10/633,288  
Docket No. MSDI-261/PC750.00

Page 12 of 18

of the plurality of fibers could be considered a wall member and the other a lighting element.”

In contrast to these assertions, Davis actually discloses that an external light source 58 applies light to each of the fiber optic bundles. See col. 3, lines 41-46. The Applicants submit that even assuming *arguendo* that one of the fibers is a wall member and the other a lighting element, there is no disclosure in Davis that one fiber supports the other fibers sufficient to maintain a position of the fibers relative to the retractor, in contrast to claim 1, which recites that the at least one wall member is frictionally engageable with the inner wall surface of the retractor to maintain a position of the lighting element relative to the retractor. Therefore, Davis also does not disclose all the features of claim 1.

Turning to independent claim 16, its features include a lighting element having at least one wall member and at least one light transmitting element along said at least one wall member, said at least one wall member being bendable to conform with the inner wall surface for frictional engagement therewith, the frictional engagement sufficient to maintain a position of the lighting element relative to the retractor. Parker et al. and Davis fail to disclose such features for at least the reasons explained in connection with the rejection of claim 1.

Claim 26 is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, amongst other features, a retractor including an inner wall surface and a lighting element including at least one wall member, “said at least one wall member frictionally engageable with said inner wall surface, wherein said lighting element is movable axially along said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface.” Parker et al. and Davis do not disclose that at least one wall member of the light transmitting member 2810 or the tubular members 50, 51 is frictionally engageable with the accessory device 2860 or the retractor 10, respectively, as discussed above in regard to claim 1. Moreover, neither of the patents discloses a lighting element “movable axially along said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface.” The Office Action fails to identify and a review of the references fails to reveal any disclosure of these features. Therefore, the ‘356 patent and the ‘214 patent fail to disclose all the features of claim 26.

Claim 36 is submitted as patentable over Parker et al. and Davis at least because the patents do not disclose that at least one wall member of the light transmitting member 2810 or the tubular members 50, 51 is frictionally engageable with the accessory device 2860 or the retractor 10, respectively, as discussed above in regard to claim 1. Additionally, as discussed in the January 31, 2007 Response to Office action, neither of the patents discloses a lighting element "movable circumferentially about said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface." Specifically, Davis discloses that the tubular members 50, 51 are soldered to the blade 12 of the retractor 10. Therefore, it is respectfully submitted that the tubular members 50, 51 are not movable circumferentially relative to the retractor 10. In the Response to Arguments section, the Examiner stated "one of the plurality of fibers could be considered a wall member and the other a lighting element." Office Action, page 4. As discussed above with reference to claim 1, nothing in Davis supports this position. In contrast, Davis is silent as to a lighting element "movable circumferentially about said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface."

Furthermore, considering that Parker et al. disclose mechanical or adhesive connectors for attaching the accessory device 2860 to the light transmitting member 2810, it is submitted that member 2810 is not circumferentially movable relative to device 2860. The Examiner, in the Response to Arguments section, stated "the embodiment of Figures 25A and 25 B does not show mechanical fasteners." Office Action, page 4. In contrast, Parker et al. is silent as to how and/or even if the lighting device of Figures 25A and 25B is attachable to the retractor 2860. Accordingly, claim 36 is submitted as patentable over Parker et al. and Davis and the Applicants respectfully request withdrawal of the rejection of independent claim 36 as being anticipated thereby.

Claim 46 also stands rejected under 35 U.S.C. §102(b) as being anticipated by Parker et al. and Davis. Claim 46 is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, a retractor positionable with the body of the patient and including an inner wall surface defining a working channel therealong and a lighting element including a pair of wall members and at least one light transmitting element between said pair of

wall members, said pair of wall members forming a concavely curved inner wall surface of said lighting element and an opposite convexly curved outer wall surface of said lighting element, said outer wall surface positionable along said inner wall surface of said retractor with said inner wall surface of said lighting element oriented toward and exposed to said working channel.

It is respectfully submitted that Parker et al. does not disclose a lighting element with a concavely curved inner wall surface oriented toward and exposed to a working channel as that feature is set forth in claim 46. As discussed in the January 31, 2007 Response to Office Action, Parker et al. discloses a light transmitting member 2810 with a circular cross-section, which, as best seen in FIG. 28B, includes a convexly curved outer surface 2802 which extends about member 2810 and is exposed to the working channel provided by accessory device 2860. However, concavely curved inner surface 2804 is not exposed to the working channel. Additionally, the embodiment of Figures 25A and 25B fails to disclose a concavely curved inner wall surface of the lighting element and further fails to disclose that the concavely curved inner wall surface of the lighting element is oriented toward and exposed to the working channel of the retractor.

With regard to Davis, it does not disclose that either of the members 50, 51 include wall members. Moreover, the concavely curved inner surface of the tubular members 50, 51 is not exposed to the working channel provided by retractor 10. Additionally, referring to one of the fibers as a wall member and the other a lighting element would not correct the deficiency of Davis. Applicants respectfully request withdrawal of the rejection of independent claim 46 as being anticipated by Parker et al. and Davis.

In addition to the patentability of the corresponding base claims, further reasons support patentability of rejected dependent claims. For example, claims 3, 18, 28, 38 "wherein said at least one wall member includes an inner wall member and an outer wall member, said plurality of light transmitting elements being positioned in a passage between said inner wall member and said outer wall member." Claims 3, 28 and 38 were not rejected by Davis, therefore it is not understood how Davis could be properly considered to disclose these same features recited in claim 18. Accordingly, Davis does not anticipate claim 18.

Claims 6, 19, 29 and 39 recite "wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting

element extends about at least 50 percent of said inner wall surface." Neither Parker et al. nor Davis disclose a retractor with an inner wall surface that substantially encloses the working channel. Rather, the retractors disclosed therein are not substantially enclosed by an inner surface to which a lighting element is engaged. Thus, these claims are allowable.

Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." Neither Parker et al. nor Davis disclose an arrangement of elements where at least one wall member of the lighting element maintains friction engagement with the retractor while the lighting element is movable axially or circumferentially. Rather, as discussed above, each reference discloses an arrangement where any wall member of the lighting element is fixed in position relative to the retractor, and no arrangement is disclosed that permits axial or circumferential movement while maintaining frictional engagement. Accordingly, these claims are allowable.

Therefore, for at least these reasons, claims depending from rejected base claims 1, 16, 26, 36 and 46 that were rejected as anticipate by Parker et al. and Davis are allowable. Withdrawal of the rejection of these claims is respectfully requested.

With regard to the rejections of the dependent claims under 35 USC §103(a), claim 4 was rejected as unpatentable over Parker et al. in view of McDonald. Claim 4 depends from claim 1 and is allowable at least for the reasons claim 1 is allowable.

With regard to the §103(a) rejection of dependent claims 9-14, 22-24, 32-34 and 42-44 in view of Parker et al. alone, the Office Action asserts: "it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the cover portions with convex and concave shapes, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a cover portion." Office Action, page 3. The Office Action has provided no showing as to why it would have been obvious to modify Parker et al. in such a manner. The Supreme Court in the recent decision of

KSR International Co. v. Teleflex Inc., \_\_\_ U.S. \_\_\_, 82 USPQ2d 1385, 127 S.Ct 1727, 167 L.Ed.2d 705 (U.S. 2007), stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit... ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

KSR, 82 USPQ2d at 1396 (citations removed). Therefore, the Office Action lacks the required cogent rationale for the proposed modifications.

Furthermore, the assertion that "applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a cover portion" is not supported in fact. One example of a problem solved by the configuration of the configuration is clearly discussed at paragraph [0026] of the publication of the present application. The claimed shape corresponds to the shape of the working channel so that the working channel remains substantially unobstructed by the lighting element so that surgical instrument can be employed in the working channel while the lighting element remains engaged to the retractor in the working channel. Accordingly, the rejection of claims 9-14, 22-24, 32-34 and 42-44 is traversed and withdrawal of the same is respectfully requested.

With regard to the §103(a) rejection of dependent claims 15, 25, 35 and 45 over Parker et al. in view of Zhu et al., these claims depend from base claims that are allowable for the reasons provided above. Therefore, withdrawal of the rejection of these claims is respectfully requested.

New claims 55-59 have been added in this response, and depend from claims 46, 1, 16, 26 and 36, respectively. Support for the new claims is found at least in paragraph [0021] of the publication of the present application. The new claims recite a structural connection between the wall members and the light transmitting element that is not disclosed in the cited references. Allowance of claims 55-59 is respectfully requested.

Response to Non-Final Office Action  
Application No. 10/633,288  
Docket No. MSDI-261/PC750.00

Page 17 of 18

RECEIVED  
CENTRAL FAX CENTER

AUG 01 2007

## CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance with pending claims 1-29, 31-40, 42-49 and 55-59. Reconsideration of the present application as amended is respectfully requested. Timely action towards a Notice of Allowance is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:

By:

Douglas A. Collier  
Reg. No. 43,556  
Krieg DeVault LLP  
2800 One Indiana Square  
Indianapolis, Indiana 46204-2079  
Phone: (317) 238-6333

Response to Non-Final Office Action  
Application No. 10/633,288  
Docket No. MSDI-261/PC750.00

Page 18 of 18

O-EFXXRF-3/10 \* DNIS: 2738300 \* CSID: 1 DURATION (mm:ss): 00:00